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4 JAMES M. SWANSON,  
5 Plaintiff,  
6 v.  
7 ALZA CORPORATION,  
8 Defendant.  
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12 UNITED STATES DISTRICT COURT  
13 NORTHERN DISTRICT OF CALIFORNIA

14 Case No. 12-cv-04579-PJH (KAW)  
15 ORDER REGARDING 7/9/14 JOINT  
16 DISCOVERY LETTER

17 Dkt. No. 190

18 On July 9, 2014, the parties filed a supplemental joint letter regarding whether Plaintiff  
19 could properly withhold documents between him and the University of California under the  
20 community of interest doctrine. (7/9/14 Joint Letter, “Joint Letter,” Dkt. No. 190.)

21 Upon review of the joint letter, the Court finds that Plaintiff did have a community of  
22 interest with the University of California, and may withhold those documents so designated in the  
23 privilege log. (Dkt. No. 190, Ex. A.)

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25 **I. DISCUSSION**

26 Plaintiff James M. Swanson claims that he should be a named inventor of Concerta, an  
27 ADHD drug developed and patented by Defendant ALZA Corporation. Plaintiff was employed  
by the University of California (“UC”), and one condition of his employment was his “legal  
obligation to assign all rights to his invention to UC, and UC’s legal obligation to review those  
inventions.” (Joint Letter at 5.) The instant discovery dispute concerns whether the documents  
exchanged between Plaintiff and UC from November 11, 2011 through August 23, 2012, when  
Plaintiff may have been negotiating with UC for the assignment of patent rights, are privileged  
pursuant to the community of interest doctrine. (Joint Letter at 1, 5 n. 4.)

28 The community of interest privilege “applies where (1) the communication is made by

1 separate parties in the course of a matter of common [legal] interest; (2) the communication is  
2 designed to further that effort; and (3) the privilege has not been waived.” *Nidec Corp. v. Victor*  
3 *Co. of Japan*, 249 F.R.D. 575, 578 (N.D. Cal. July 5, 2007) (quoting *United States v. Bergonzi*,  
4 216 F.R.D. 487, 495-96 (N.D.Cal.2003)).

5 First, as a UC employee at the time of his alleged inventorship, Plaintiff and UC share a  
6 common legal interest in whether he should be a named inventor of Concerta. *See In re Regents of*  
7 *Univ. of California*, 101 F.3d 1386, 1390 (Fed. Cir. 1996)(community of interest exists between a  
8 licensee and UC, because they “shared the interest that UC would obtain valid and enforceable  
9 patents”). Despite Defendant’s contention to the contrary, this is similar to *In re Regents*, because  
10 Dr. Swanson’s employment agreement creates a legal relationship where he assigned his  
11 intellectual property rights to UC. *See id.* at 1388-89. That Plaintiff had to obtain a reassignment  
12 of rights from UC to proceed with this lawsuit does not render those negotiations adversarial or  
13 mean that Plaintiff and UC did not share a common legal interest.

14 Second, these communications were obviously made in anticipation of litigation to protect  
15 Plaintiff’s and UC’s alleged intellectual property rights and to further a legal effort and strategy,  
16 namely whether Plaintiff could pursue this litigation or if UC would have to enforce the rights  
17 Plaintiff assigned to it as a UC employee. *See Nidec Corp.*, 249 F.R.D. at 579; *see also Hewlett-*  
18 *Packard Co. v. Bausch & Lomb, Inc.*, 115 F.R.D. 308, 310 (N.D. Cal. April 9, 1987) (finding an  
19 “identical issues of law and of fact” based on the validity and enforceability of the same patent).

20 Lastly, there is no indication that the privilege has been waived by any third party.

21 Accordingly, Plaintiff and UC shared a community of interest, which was not disrupted by  
22 the assignment discussions, rendering the documents privileged and not subject to disclosure.

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## II. CONCLUSION

In light of the foregoing, the documents exchanged between Plaintiff and UC regarding the assignment of patent rights and the instant litigation are privileged and need not be produced.

IT IS SO ORDERED.

Dated: July 18, 2014

Kandis Westmore  
KANDIS A. WESTMORE  
United States Magistrate Judge

United States District Court  
Northern District of California